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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,081	11/08/2004	Martin Kreyenschmidt	260985US0PCT	2789

22850 7590 01/17/2007
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

COONEY, JOHN M

ART UNIT	PAPER NUMBER
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1711

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/17/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/512,081

Applicant(s)

KREYENSCHMIDT ET AL.

Examiner

John m. Cooney

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 1104.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,3-5, and 7-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “waxes” as defined by applicants’ supporting disclosure does not provide support for materials beyond waxes as defined by applicants but which otherwise meet the requirements set forth by the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants’ supporting disclosure does not provide enablement for practice of the full scope of the instant claims as they are now recited without undue experimentation being required. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404.

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specifically defined classes of inhibitor materials as defined by claim 7 does not reasonably provide enablement for any materials which inhibits at least one thing. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Applicants’ supporting disclosure does not provide enablement for practice of the full scope of the

instant claims as they are now recited without undue experimentation being required. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "inhibitor" in claims 1-10 is a relative term which renders the claims indefinite. The term "inhibitor" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Without the claim defining what is being inhibited, the intended limitations of the claims can not be determined.

Claims 2 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' set forth a meaning for "waxes" in the context of their invention at page 3 lines 16-17 which is in conflict with and extends the meaning of the term beyond materials included within the generally accepted group of materials known as waxes. While applicant may be their own lexicographer, the entirety of applicants' disclosure

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except for page 3 lines 16-17 treats "waxes" in accordance with their accepted meaning in the art. Accordingly, the intended meaning of the term "wax" can not be determined and the claims are confusing as to intent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-10 are rejected under 35 U.S.C. 102(e) as being anticipated by DE 100 50 417.

DE 100 50 417 discloses preparations of polyurethane composition prepared from isocyanates and polyols containing materials including compounds reading on inhibitors as claimed that are embedded in waxes as defined by applicants' claims (see the entire document). The properties of the embedding substance though not specifically highlighted by DE 100 50 417 are inherent features associated with embedding substances disclosed by DE 100 50 417 because such are intrinsic properties associated with the embedding substances disclosed to be employed by DE 100 50 417.

Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Hall et al.(4,670,483).

Hall et al. discloses preparations reading on those defined by applicants which include polyurethane compositions as defined by applicants prepared from isocyanates and polyols containing materials that further include compounds reading on inhibitors, ammonium polyphosphate (an ester), as claimed that are embedded in substances as defined by applicants' claims, as well as, being further embedded in waxes, such as montan wax ester, to degrees as required by applicants' claims (see column 8 line 6-54, as well as, the entire document). The properties of the embedding substance though not specifically highlighted by Hall et al. are inherent features associated with embedding substances disclosed by Hall et al. because such are intrinsic properties associated with the embedding substances disclosed to be employed by Hall et al.

Claims 1-6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Natoli et al.(5,585,412)

Natoli et al. discloses preparations reading on those defined by applicants which include polyurethane compositions as defined by applicants prepared from isocyanates and polyols containing materials that further include compounds reading on inhibitors as claimed that are embedded in substances as defined by applicants' claims to degrees as required by applicants' claims (see column 3 line 6-26, as well as, the entire


document). The properties of the embedding substance though not specifically highlighted by Natoli et al. are inherent features associated with embedding substances disclosed by Natoli et al. because such are intrinsic properties associated with the embedding substances disclosed to be employed by Natoli et al.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Freitag et al.(6,479,560) and Czaplicki (6,730,713) are cited for its disclosure of related wax encapsulations in other polymer formulations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JOHN M. COONEY, JR.
PRIMARY EXAMINER
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